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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,164	11/13/2001	Simon Muff	MAS-FIN-200	7203
24131	7590	05/07/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			MITCHELL, JAMES M	
			ART UNIT	PAPER NUMBER
			2827	

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,164

Applicant(s)

MUFF ET AL.

Examiner

James M. Mitchell

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kozuka (US 5,691,570).

Kozuka (Fig 21; Col. 9, Lines 29-36) discloses a component placement method and integrated circuit chip comprising inherently providing an integrated chip containing a chip body (12) having an upper side and a under side, and at least two groups of metallic bonding pads (20, 16; 16, 20; via integral with metal 449) disposed on one of said upper side (Left portion) and underside (Right portion) of said chip body, wherein the first group (20,16) is inherently ordered in the standard pin/ wiring assignment or configuration (via "normal configuration"; Col. 1, Lines 9-13) and a second group (16, 20) of said at least two groups of said metallic bonding pads inherently ordered in the mirror-image pin assignment or wiring configuration (via "reverse configuration), the mirror-image wiring configuration being mirror-inverted in relationship the standard wiring configuration (20,16; 16,20) and at least groups of metallic bonding pads (16) disposed on one of said upper side (Left portion) and said under side (Right portion) of

said chip body, first group (122) of said at least two groups of said metallic bonding pads ordered in the standard assignment, a second group (124) said least two groups said metallic bonding pads ordered in the mirror-image pin assignment; and using the IC circuit for placing components on at least one side of a printed circuit board using surfaces mounting technique (Claim 6, line 63-64).

With respect to the chip body being able “to be connected optionally to one of a standard wiring configuration for a standard pin assignment and to a mirror image wiring configuration for a mirror image pin assignment [etc],” the prior art is capable of performing the functions (Col. 1, Lines 9-13). The courts have held that the recitation that an element is “capable of” performing a function is not a positive recitation, but only requires the ability to so perform. In re Hutchinson, 69 USPQ 138 (CCPA 1946).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuka (US 5,691,570) as applied to claim 1.

Kozuka (Fig 21) further discloses the standard wiring configuration and the mirror-image wiring configuration in each case extends on opposite sides of the chip body (via Left side and Right side); and the first group is disposed in a first row and said second group is disposed in a second row next to each other along two straight lines

running parallel to each other; wherein the pads of the first and second row have a same spacing in relation to directly neighboring bonding pads (via 448, 449); with pins of the metallic pads of the first and second group are in a same direction; and the pads of the first and second group are lying in a common row lie along a straight line.

Kozuka does not appear to disclose the standard pin is realized by a positioning of said chip body first position, the mirror- image pin assignment realized by a positioning of said chip body in a second position and once in the second position can be transformed into the first position by rotation of said chip according chip body said upper side or said underside chip body or by translational movement said chip body along straight running parallel said upper side or to said underside said chip body wherein from a transformation from the second position into the first position, and vice versa, in each case, rotating said IC chip body by one of 90 , 180 and 270 degrees is required.

With respect to product by process claim of "the standard pin is realized by a positioning of said chip body first position, the mirror- image pin assignment realized by a positioning of said chip body in a second position and once in the second position can be transformed into the first position by rotation of said chip according chip body said upper side or said underside chip body or by translational movement said chip body along straight running parallel said upper side or to said underside said chip body wherein from a transformation from the second position into the first position, and vice versa, in each case, rotating said IC chip body by one of 90 , 180 and 270 degrees is required," or "pins... assigned in a same direction." The product is the same as that of

the prior art. [E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Response to Arguments

Applicant's arguments filed January 15, 2004 have been fully considered but they are not persuasive.

First, applicant contends that Kozuka does not show at least two groups of metallic bonding pads citing Fig. 16 for support, because allegedly it contains the same number of pads as pins. Besides the fact that Fig 21, which was relied on in the rejection is a different embodiment than Fig. 16, applicant's claim language does not preclude pads and pins from having a different number as argued by applicant.

Secondly, applicant attempts to distinguish its invention by stating that mounting of the chip to either a standard or mirror image orientation is achieved by rotating the chip, is immaterial, because that process limitation did not structurally limit the product invention as claimed and was not further included in the method claim. Likewise, applicant's arguments that the chip of Kozuka cannot be mounted in both the standard and mirror-image configuration is found unpersuasive for the reasons stated above.

Lastly, applicant asserts on page 11 of its remarks that “the inclusion of two groups of bonding pads in different configurations on a single chip is inventive.”

Examiner respectfully disagrees, since that invention is explicitly disclosed by Kozuka (Fig. 21) as indicated in the office action.

Conclusion

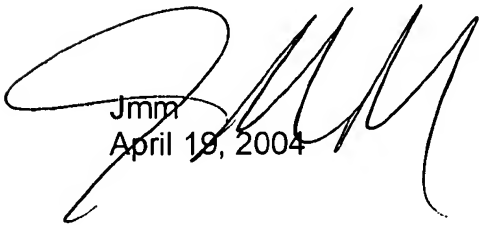
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Mitchell whose telephone number is (571) 272-1931. The examiner can normally be reached on M-F 6:30-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jmm
April 19, 2004


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